

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re _____)
)
)

DECISION ON REQUEST FOR WITHDRAWAL OF PETITION TO REVIEW

, petitioner, requests withdrawal of his September 16, 1997, petition to the Commissioner seeking review of the August 20, 1997, decision of the Director of Enrollment and Discipline (Director) denying him a passing score on the August 28, 1996, examination. Petitioner also seeks reimbursement of the required \$130 fee that accompanied the petition. In the alternative, Petitioner seeks a decision on the petition. The request is dismissed.

BACKGROUND

An applicant for registration to practice before the PTO in patent matters must achieve a passing grade of 70 on both the morning and afternoon section of a registration examination. Petitioner sat for the August 28, 1996, registration examination. He received a passing score on the afternoon section of the examination, but a failing score (64) on the morning section. On April 7, 1997, Petitioner requested regrade of the morning section of the examination. See 37 C.F.R. § 10.7(c). Petitioner's regrade request was accompanied by the required \$225 fee. On August 20, 1997, the Director issued a decision on Petitioner's request. Her decision increased his score by 2 points, to 66. On September 16, 1997, Petitioner requested the Commissioner's review of the Director's August 20, 1997, decision. See 37 C.F.R. 10.2(c). His petition was accompanied by the required \$130 fee. On May 19, 1998, the Commissioner dismissed the petition because it had been rendered moot. It had been rendered moot because, in the interim,

Petitioner applied to take, and successfully sat for, the morning section of the August 27, 1997, registration examination. 37 C.F.R. 10.7(b).

Petitioner requests withdrawal of his September 16, 1997, petition to the Commissioner and reimbursement of the \$130 fee that accompanied the petition, or if that is not possible, a decision on the petition.

DISCUSSION

Petitioner's instant request to withdraw his petition, dated April 17, 1998, appears to have crossed paths with the Commissioner's decision on the petition, dated May 19, 1998, which dismissed the petition as moot because Petitioner passed the morning section of the August 27, 1997, examination. Thus, subsequent events have rendered the request to withdraw the petition moot.

Even if the petition had been received in time to grant the withdrawal request, Petitioner would not have been entitled to a reimbursement. Title 35 U.S.C. § 42(d) permits the Commissioner to refund "any fee paid by mistake or any amount paid in excess of that required." After receiving notice that he had failed the morning section of the August 28, 1996, examination, Petitioner had two choices--seek a regrade of the scoring on the morning section or retake the morning section of the examination. Each choice had certain time limits that required the payment of a fee in order to file a paper and preserve legal rights. Petitioner choose to do both, and in so doing, incurred the respective fees. Ultimately, he was unsuccessful on his request for regrade, but successful on his retake of the morning section of the examination. Thus, Petitioner has received what he sought--admission to practice before the PTO in patent matters. Accordingly, Petitioner's \$130 fee was not paid by mistake or in excess of what was required. See Miessner v.

United States, 108 USPQ 6, 7 (D.D.C. 1955) (refund of appeal fee paid after examiner's final rejection but prior to examiner's withdrawal of final rejection was not fee paid by mistake).

In the alternative, Petitioner requests a decision on the petition. As noted above, the petition was dismissed as moot because Petitioner passed the morning section of the August 27, 1997, examination. A petition for regrade seeks a determination that the petitioner possesses one of the "necessary qualifications" needed to render patent applicants valuable assistance.

35 U.S.C. § 31. See also 37 C.F.R. § 10.7(b). In the instant case, such a determination was made when Petitioner successfully sat for the afternoon section of the August 28, 1996, examination and the morning section of the August 27, 1997, examination. See Brownlow v. Schwartz, 261 U.S. 216, 217 (1923) (ordering dismissal of a petition because relief sought by petitioner had already been granted, thereby, rendering the issue moot). See also Mills v. Green, 159 U.S. 651, 653-654 (1895) (holding that when "intervening event is owing either to the plaintiff's own act or to a power beyond the control of either party, the court will stay its hand").

CONCLUSION

Petitioner's request to withdraw his petition or, in the alternative, have the petition decided, has been rendered moot. Accordingly, it is ORDERED that the petition is dismissed.

JUL 20 1998

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", is written over a horizontal line.

Q. TODD DICKINSON

Deputy Assistant Secretary of Commerce and
Deputy Commissioner of Patents and Trademarks